



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Jean-Louis GUERET

Group Art Unit: 3728

Application No.: 10/766,916

Examiner: J. PICKETT

Filed: January 30, 2004

Docket No.: 118335

For: A BOX INCLUDING A HINGE HAVING A LOOP ELEMENT AND A HOOK
ELEMENT

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following remarks are directed to the new points of argument raised in the Examiner's Answer dated January 18, 2008. As explained in detail below, the Examiner's Answer improperly applies the law regarding obviousness in an unreasonable attempt to maintain the rejections of the pending claims. The Examiner's Answer erroneously relies on the theory of art-recognized equivalents, where no equivalence has been shown, and misapplies recent judicial precedent. Appellant respectfully submits that the Examiner's Answer fails to adequately address Appellant's arguments regarding the non-obviousness of the present subject matter over the applied references, and that, upon a proper application of the law, the present subject matter would not have been obvious.

I. U.S. Patent No. 6,626,432 Is Not Analogous Art.

The Examiner's Answer maintains that U.S. Patent No. 6,626,432 to Rago is analogous art, and that it is properly combined with either of U.S. Patent Application No. 2002/0153376 to Seidler or U.S. Patent No. 7,047,983 to Manougian et al. (hereinafter "Manougian"). These assertions are incorrect.

Rago is directed to a game board, and playing card retention clips, for use in windy conditions (see Abstract). Manougian discloses a cosmetic case, including a pin hinge 220. Seidler deals with a virtual hinge using magnets to define a virtual hinge axis of an exemplary cosmetic case. The Examiner's Answer, on page 11, attempts to rely on the precedent of *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992) in asserting that Rago is analogous art. The Examiner's Answer states that Rago is "reasonably pertinent to hinges, and more particularly separable hinges," in support of this assertion. However, *Oetiker* itself demonstrates, on the contrary, that the broad assertion by the Examiner is unreasonable. Specifically, *Oetiker* rejected the similar assertion that a "hook" used to secure a garment would have logically commended itself to one of ordinary skill in the art looking to modify a "hook" used for a hose clamp. The court in *Oetiker* found this argument was not supportable (see *Oetiker*, 977 F.2d at 1446). The mere fact that both references dealt with a hook fastener, even when a hook fastener was the significant feature of the application, was not sufficient to render the references analogous because all "hooking problems" are not analogous. In other words, the standard that a reference be reasonably pertinent to the particular problem with which the Appellant was concerned requires more than a showing that the reference has a certain feature.

Similarly, the mere inclusion of a "hinge" does not render a reference *per se* analogous to Manougian, Seidler or the subject matter of the pending claims.

A review of the other judicial precedent relied-upon by the Examiner further illustrates the unreasonableness of the combination of Rago with either of the other applied references. For example, the Office Action relies on *Ex Parte Smith*, 83 USPQ.2d 1509 (BPAI 2007) in attempting to assert that the present subject matter involves a simple substitution of one known element for another. *Smith* dealt with a pocket insert for a bound book. The references at issue in that case (U.S. Patent No. 1,495,953 to Dick and U.S. Patent No. 5,540,513 to Wyant) both dealt with inserts used in loose-leaf binders. The obviousness of the combination of features in these references cannot reasonably be considered to support the conclusion that it would have been obvious for an ordinarily skilled designer of cosmetic cases to have looked to a game board.

Likewise, in *KSR v. Teleflex*, 127 S.Ct. 1727 (2007), the Supreme Court found that the prior art taught all of the elements at issue in the field of automotive pedal designs. Holding that one of ordinary skill in the art of automotive pedal designs would have looked to various electronic and mechanical automotive pedal designs, does not undermine the central holding of *Oetiker* or support the conclusion that all references with a hinge satisfy the requirements of analogous art.

The Examiner's Answer fails to establish that Rago satisfies the requirements of analogous art with respect to the other applied references or the present subject matter.

II. The Hook-And-Loop Configuration Of Rago Was Not An Art Recognized Equivalent Of The Wired Or Virtual Cosmetic Case Hinges.

The Examiner's Answer broadly asserts that Rago shows that a hook-and-loop hinge was an "equivalent structure known in the art." Evidence that the alleged hook-and-loop "hinge" in Rago may have been known to be effective for securing pieces of a game board together, does not establish that it was an "art recognized" equivalent for the purposes of wired, or virtual, cosmetic case hinges. MPEP §2144.06 (II) specifically states that, in order

to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on Appellant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents. The Examiner has not demonstrated that the hook-and-loop configuration of Rago was a recognized equivalent of either of the cosmetic case hinges disclosed in Seidler or Manougian. Additionally, the hook-and-loop configuration of Rago would not be understood as equivalent to these configurations.

For example, there is no showing that a hook-and-loop configuration would be equivalent to a wired hinge in terms of strength and suitability for use in joining small elements such as cosmetic cases. Likewise, the Examiner's Answer does not establish that the stability of the virtual hinge in Seidler would be considered equivalent to the stability of the configuration in Rago, and does not address the fact that the virtual hinge taught by Seidler neither increases the physical dimensions of the hinge nor physically occupies space intermediate the plates.

As such, the assertion that Rago shows that a hook-and-loop hinge was an "equivalent structure known in the art" is improper and unsupported by the record.

III. The Office Action Misapplies Recent Precedent Regarding The Standard For Obviousness.

In the Response to Arguments, the Examiner asserts that the simple substitution of one known element for another, or the mere application of a known technique to a piece of prior art ready for improvement renders a claim unpatentable over 35 U.S.C. §103(a). The Office Action relies on *Smith* and *KSR* in support of this assertion. However, this language, quoted directly from *KSR*, is improperly applied to the subject matter of the pending claims.

The above-quoted language was used by the Supreme Court in describing how it would be more difficult in other cases to determine whether a modification was more than the

predictable use of prior art elements according to their established functions. In other words, the above-referenced "simple substitution," and application of a known technique to a piece of prior art "ready for improvement," are directed to the subject matter of the various automotive pedal designs in *KSR*. A piece of prior art "ready for improvement" in *KSR* was a known mechanical automotive pedal ready for the improvement of an electronic sensor, which was a known improvement in the field of automotive pedal design.

This language, and precedent, does not support the conclusion that the configuration of joining a specialized game board would be a simple substitution for use in a small cosmetic case, or that any cosmetic case of record was "ready for improvement" of a hook and loop hinge, that was nowhere recognized as an improvement in the field of cosmetic cases. Indeed, the Supreme Court specifically recognized that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art" (*KSR*, 127 S.Ct. at 1741, emphasis added). The Supreme Court went on to recognize that it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Neither the rejection of record, nor the Examiner's Answer, provides such a reason.

Similarly, the modification in *Smith* involved changing the seam of one loose-leaf index pocket based on the seam of another loose-leaf index pocket (see *Smith*, 83 USPQ.2d at 1517). The similarity of these references, and the specific features at issue, are not analogous to the cosmetic cases of Seidler and Manougian, and the game board, or hook and loop configuration, of Rago

The asserted modifications of Seidler and Manougian cannot reasonably be considered as either a simple substitution of one known element for another, or the mere application of a

known technique to a piece of prior art ready for improvement, under the precedent of *Smith* or *KSR*.

IV. Conclusion.

For any or all of the reasons discussed above, Appellant respectfully submits that the rejections are in error, and that claims 1-39 are in condition for allowance. Accordingly, Appellant respectfully requests this honorable Board reverse the rejections of claims 1-39.

Respectfully submitted,



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Date: March 18, 2008

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